



08 JUN 2007

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In re Application of	:	
EBERL et al.	:	
Serial No.: 10/562,230	:	DECISION ON
PCT App. No.: PCT/EP00/09841	:	
Int'l Filing Date: 07 October 2000	:	RENEWED PETITION
Priority Date: None	:	
Attorney Docket No.: 101795.56948US	:	UNDER 37 CFR 1.137(b)
For: INFORMATION SYSTEM	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.137(b)," filed in the above-captioned application on 20 November 2006.

BACKGROUND

On 07 October 2000, applicant filed an international application number PCT/EP00/09841. A demand for international preliminary examination was filed on 24 April 2002, prior to the expiration of nineteen months from the priority date. As such, the thirty month period for entering the national stage in the United States expired at midnight on 07 April 2003.

On 23 December 2005, more than two and a half years after abandonment of the international application, applicant filed a transmittal letter for entry into the national phase in the United States, accompanied by a petition to revive.

On 24 January 2006, the Office mailed Decision On Petition Under 37 CFR 1.137(b), dismissing applicants' petition without prejudice.

On 24 March 2006, applicants filed a renewed petition under 37 CFR 1.137(b). On 15 September 2006, applicant filed a supplemental renewed petition under 37 CFR 1.137(b).

On 18 September 2006, a decision dismissing the petition was mailed indicating that applicant had not provided a satisfactory explanation that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

On 20 November 2006, applicant filed the renewed petition along with a copy of the

supplemental renewed petition, which is considered herein.

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Items (1) and (2) were previously provided.

Item (3) still has not been satisfied. Regarding item (3), as stated above, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 April 2003. The application went abandoned at midnight on 07 April 2003 for failure to pay the basic national fee.

In the supplemental petition, Petitioner asserts that “in order to file in the United States, Mr. Dickerson was required to make a good faith effort to locate these individuals [co-inventors] and obtain their cooperation.” (Supp. Pet. ¶5) and “when those inventors were located agreement was finally obtained from them so as to be able to proceed.” (Supp. Pet. ¶6) As previously pointed out in the 18 September 2006 decision, applicant as an inventor had the right to file a national stage application in the United States and did not do so until 23 December 2005, more than two and a half years from the abandonment of the international application. Moreover, applicant’s inability to find the other inventors cannot be considered an excuse for applicant’s failure to file the national stage application because an application may be filed without the signatures of all inventors (see 37 CFR 1.47).

Petitioner asserts that confusion reigned regarding ownership of the application, which prevented Mr. Dickerson or anyone else from pursuing this application in the U.S. Applicant appears to claim that because the inventors were not Applicants of the PCT and could not be until ownership was transferred or released to inventors, they could not file a U.S. application. However, a review of the international applicant PCT/EP00/09841 indicates that the inventors were also applicants. See indication 75 of the published international application where Roland H. C. Eberl, Heinrich A. Eberl, Karsten Konigstein and David P. Dickerson were named applicant/inventors. (Where the national law of the designated State requires that, for the purposes of the designation of that State, the applicant(s) must be the inventor(s). See Article 27(3) and PCT Rule 18.4(c).) U.S. national law requires the inventor to be applicant for a patent. See 35 U.S.C. 101 et seq.

In the renewed petition filed on 20 November 2006, Petitioner attempts to explain the lengthy delay in filing the petition to revive as follows. Physoptics Opto-Electronic GmbH, the

owner of the invention, was in bankruptcy at the time of the expiration of the thirty month period (07 April 2003) and “did not have the necessary assets to continue prosecution of Physoptics’ numerous patent applications” (Pet. ¶14). Furthermore, the bankruptcy trustee refused to take any action with regard to filing the national stage papers in the United States. (¶14) Petitioner asserts that on 20 November 2003, after filing a lawsuit against his former employer Physoptics, Inventor Dickerson obtained the right to the invention. (Pet. ¶15) However, Petitioner did not seek to revive the application until more than two years later, on 23 December 2005.

When the issue of revival is addressed, the focus must be on the rights of the parties as of the time of abandonment. See Kim v. Quigg, 781 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va 1989). The record is not clear as to the rights of the parties on 07 April 2003, the date of abandonment. Rather, it appears that the instant application was among the assets of a bankruptcy estate. As such, the person who had control of this asset at the date in question would appear to be the bankruptcy trustee.

MPEP § 711.03(c), II. D., states that “where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as ‘unintentional’ within the meaning of 37 CFR 1.137(b).” The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on 07 April 2003. That party, in turn must explain what effort(s) was made to file a US national stage application and further, why no such application was filed. If no effort was made to file such application, then that party must explain why the delay in filing this application does not result from a deliberate decision to take no action. Likewise, the party having the right or authority to avoid abandonment should explain why this application became abandoned while it was under their control and what efforts were made to file a US national stage application and with whom this matter was discussed. Copies of any correspondence relating the filing, or not filing a US national stage application are required. It is noted that simply because bankruptcy is involved does not necessarily mean that no income was derived to the estate, that there were no funds in the bankruptcy estate, or that no bills were paid or expenses undertaken by the trustee. Simply put, a course of conduct resulting in a delay that is purposefully chosen does not qualify as unintentional delay.

Petitioner states that by virtue of German employment law, Physoptics took over the right to this application and later went into bankruptcy. A trustee was appointed; however, Physoptics did not have the necessary assets to continue prosecution of Physoptics’ patent applications. It appears that the trustee’s refusal to initiate a US national stage application was intentional and thus, the application can not be considered to be unintentionally abandoned.

On 20 November 2003, Physoptics transferred all rights to the patent applications to Mr. Dickerson” (¶19).

Thus, it appears that the PCT application was subject to the bankruptcy trustee's control until 20 November 2003. Petitioner has not detailed the time period since 07 April 2003 until the filing of the present petition. Applicant has not provided a detailed account of the knowledge and actions of the bankruptcy trustee and the other owners for the period of 07 April 2003 through the filing of the petition on 23 December 2005. If the trustee knew of the 30 month deadline for entering the National stage in the United States and did not divert funds to either timely enter the U.S. National stage or make arrangements for revival, the lack of such actions can be construed as intentional abandonment.

Furthermore, Mr. Dickerson's actions to revive the application are not detailed for the time period from when he obtained the rights to the invention to the filing of the petition, other than the simple statements that Mr. Dickerson was required to make a good faith effort to locate the joint inventors and to obtain their cooperation; that Mr. Dickerson had to reconstruct the patent application files because they had been lost or misplaced; and that "[Mr.] Dickerson lacked the necessary resources, and it was necessary for him to obtain financing...could not devote his full time to the project." (§21) Any diligent efforts Mr. Dickerson made were not explained in the petition. There is no indication of when Mr. Dickerson contacted US counsel to make inquiries about the entering of the US national stage and no explanation regarding the length of delay in filing the U.S. national stage application from that time until 23 December 2005.

Absent a detailed explanation of the knowledge and actions of the trustee, the other owners and of Mr. Dickerson himself it is not possible to grant applicant's petition. The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional.

The delay from at least November 20, 2003, when the bankruptcy trustee purportedly transferred the rights to Mr. Dickerson, until the filing of the U.S. Basic National Fee on 23 December 2005 still has not been adequately explained. A delay due to applicant's deliberately choosing other priorities over filing the instant application appears to be an intentional delay.

CONCLUSION

For the reasons above, applicant's petitions under 37 CFR 1.137(b) is **DISMISSED**. The application remains **ABANDONED** as to the United States of America.

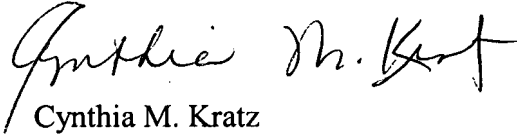
Any reconsideration on the merits of this petition must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to Mail Stop

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PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450,
Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the
Office of PCT Legal Administration.

A handwritten signature in cursive script, appearing to read "Cynthia M. Kratz".

Cynthia M. Kratz

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